

REMARKS

Entry of the foregoing, reexamination and reconsideration of the subject application, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested in light of the remarks which follow.

I. Amendments to the Claims

By the foregoing amendments to the claims, claim 7 has been amended, and claims 16 and 17 have been added.

In particular, claim 7 has been amended to recite that the angiogenesis-related disease is selected from the group consisting of cancer and rheumatoid arthritis.

New claims 16 and 17 recite particular embodiments of claim 7.

The amendments to the claims, including cancellation of claims, have been made without prejudice or disclaimer to any subject matter recited or canceled herein. Applicants reserve the right to file one or more continuation and/or divisional applications directed to any canceled subject matter. No new matter has been added, and entry of the foregoing amendments to the above-identified application are respectfully requested.

II. Response to Claim Rejections Under 35 U.S.C. § 112, First Paragraph

At pages 2-3 of the Office Action, claims 1, 4-7 and 13-15 have been rejected under 35 U.S.C. § 112, first paragraph, as purportedly lacking enablement.

In particular, the Examiner has acknowledged that the specification enables treating rheumatoid arthritis and melanoma. However, the Examiner has also stated that the specification does not enable treating any of the additional diseases recited in claim 7. Furthermore, it is the Examiner's newly stated position that the animal model data for rheumatoid arthritis and melanoma cannot predict the efficacy of the method for all patients in need of endothelial cell adhesion, endothelial cell migration, or angiogenesis inhibition. Thus, the Examiner has concluded that claims 1 and 4-6 (previously indicated as allowed) are also not enabled.

This rejection is respectfully traversed.

Claims 1 and 4-6 are directed to methods for inhibiting endothelial cell adhesion, endothelial cell migration, and/or angiogenesis, not to methods for treating diseases.

Examples 4, 5 and 6 of the present application show that the adhesion of endothelial cells is inhibited by the recited peptides. Example 7 shows that endothelial cell migration is inhibited by the peptides. In addition, Example 8 shows that the recited peptides inhibit angiogenesis. Therefore, the skilled artisan would be not burdened with undue experimentation in determining if the peptides could be used to inhibit endothelial adhesion, endothelial cell migration, and/or angiogenesis.

With regard to claims 7 and 13-15, Applicants submit that one of ordinary skill in the art would have reasonably predicted that the recited peptides would be useful for treating cancer as well as for treating rheumatoid arthritis. As stated in *Capon v. Eshhar*, 418 F.3d 1349, 1359, (Fed. Cir. 2005), "it is not necessary that every permutation within a generally operable invention be effective in order for an inventor to obtain a generic claim, provided that the effect is sufficiently demonstrated to characterize a generic invention." Also, the scope of enablement must only bear a "reasonable correlation" to the scope of the claims. See, e.g., *In re Fisher*, 427 F.2d 833, 166 (CCPA 1970).

In the present patent application, melanoma and lung cancer are examples of cancers that have been shown to be suitable for treatment with the recited peptides. In particular, Applicants submit herewith a Declaration of Dr. Kim (a named inventor of the present application). The experiments detailed in the Declaration submitted herewith show that a Bih-h3 comprising peptide within the scope of the present claims (SEQ ID NO: 1 of the present invention) is suitable for treating cancer in the lung cancer animal model. A prior Declaration of Dr. Kim has demonstrated that a peptide within the scope of the present claims is also suitable for treating cancer in a melanoma model (see the response filed July 7, 2008; see also page 3 of the October 14, 2008 Office Action). Furthermore, as noted above the present specification demonstrates that the recited peptides have angiogenesis inhibitory activity, and angiogenesis inhibitors are known to be useful as anti cancer drugs. Accordingly, Applicants submit that a person of ordinary skill in the art would reasonably predict that the peptides recited in the present claims would be also be suitable for treating other cancers.

As demonstrated above, the methods recited in the present claims are enabled commensurate in scope with the claims. Therefore, Applicants respectfully request reconsideration and withdrawal of this rejection.

CONCLUSION

In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited. In the event that there are any questions relating to this Amendment and Reply, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: February 16, 2009

By:



Lisa E. Stahl

Registration No. 56,704

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620